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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,528	02/13/2002	Seng Tan	1563 (WRIGHT)	8952
30010	7590	07/16/2004	EXAMINER	
AUZVILLE JACKSON, JR. 8652 RIO GRANDE ROAD RICHMOND, VA 23229			FOELAK, MORTON	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/075,528	TAN, SENG	
	<b>Examiner</b>	<b>Art Unit</b>	
	Morton Foelak	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 22-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**1. Applicant's election with traverse of claims 9-21 in the reply filed on 4/19/04 is acknowledged. The traversal is on the ground(s) that the requirement is not proper because the elected claims are product by process claims and one would have to search the process in order to find the product. However attention is directed to the fact that while applicant may be correct in his position, it is noted that product by process claims are deemed product claims and said claims do not necessarily have to be made by the same process. Claims 1-8 and 22-25 are withdrawn from further consideration as being drawn to another invention.**

**The requirement is still deemed proper and is therefore made**

**FINAL.**

***Double Patenting***

**2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).**

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**A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).**

**Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).**

**3. Claims 9-21 are rejected under the judicially created doctrine of double patenting over claims 8-16 of U. S. Patent No. 6,555,589 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.**

**The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:**

**The instant claims are broader than and read on the product claims of the patent. In addition it is deemed that the claimed product would inherently have the same transparency and void size and be a powder since the temperatures and pressures used in the methods of both cases would be similar.**

**Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the**

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**instant application during prosecution of the application which**

**matured into a patent. See *In re Schneller*, 397 F.2d 350, 158**

**USPQ 210 (CCPA 1968). See also MPEP § 804.**

***Claim Rejections - 35 USC § 103***

**4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

**(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.**

**5. Claims 9-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/17533 taken with Keiser.**

**6. Patentees disclose making a nanocomposite or molecular-composite polymer by extruding and foaming with the use of carbon dioxide blowing agent and temperatures and pressures used in the instant case. The steps of fully or partially releasing the pressure and controllably quenching the polymer during the process are also read on the steps employed in the references (page 9, 11, 15 and 16 lines 6 and 7 which calls for the claimed quenching step in their extrusion**

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**process of the WO patent and col. 8 line 19-23 and col. 6 lines 24 –65 and particularly line 41 and 46-58 of Keiser where blends of polymers of the disclosed type to be foamed are disclosed) Both patentees also call for nucleation in their processes (first par. including line 6 of col. 6 ).**

**7. Since both references disclose a similar process to that claimed there would be motivation to use the nucleating agents and the polymer blends of Keiser in the process of the WO patent or employ the quenching or cooling of the WO patent,**

**8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:**

- 1. Determining the scope and contents of the prior art.**
- 2. Ascertaining the differences between the prior art and the claims at issue.**
- 3. Resolving the level of ordinary skill in the pertinent art.**
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.**

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**Any inquiry concerning this communication or earlier communications from the examiner should be directed to Morton Foelak whose telephone number is (571) 272-1071. The examiner can normally be reached on Monday thru Friday.**

**If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.**

**Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).**

  
**Morton Foelak**

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**M.F.**

**July 9, 2004**

**Primary Examiner**

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